

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

CAI *et al.*

Appl. No.: 10/510,104

§ 371 Date: April 5, 2005

**For: Caspase Inhibitors for the Treatment of
Diseases and Conditions Caused by
Exposure to Radionuclides, Biological
Agents, or Chemical Agents**

Confirmation No.: 5087

Art Unit: 1609

Examiner: Kudla, J.S.

Atty. Docket: 1735.0760002/RWE/BSA

Reply to Restriction Requirement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated September 11, 2007, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute Cbz-Val-Asp-CH₂F. Claims 1-18 read on the elected compound. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made with traverse.

The Examiner considers that claims 1-26 lack the same or corresponding special features because methods of using caspase inhibitors are well known in the art. In support of this position, the Examiner cites U.S. Published application 2003/0114447 ("the '447 application") which teaches caspase inhibitors and their use for the treatment of disorders caused by excessive apoptosis. Applicants respectfully disagree.

What the '447 application does not teach is the use of caspase inhibitors to treat, ameliorate or prevent a disease caused by exposure to radionucleotides, biological agents

or chemical agents. This technical feature is not taught by the '447 application. Thus, claims 1-26 in fact do share a common technical feature which is not taught by the art.

Moreover, the Examiner is of the opinion that "[t]he caspase inhibitor compounds of claims 17-26 encompass many different and distinct composition [which] vary distinctly in their structures and functions" and concluded that each individual composition is a single invention. As a result, the Examiner required that Applicants elect a specific compound as a single invention. Office action, page 2. Applicants traverse this requirement.

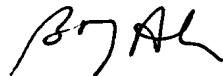
Applicants note that all the compounds used in method claims 17-26 are substituted aspartic acid compounds and therefore share a common feature. More specifically, the compounds used in 17-22 and 25-26 contain a substituted Aa-Asp core structure (where Aa is a peptide of at least one amino acid and Asp is aspartic acid) and therefore share a special technical feature. Under MPEP 1893.03(d), "[a] group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature." Consistent with the MPEP, the Examples of the International Search and Preliminary Examination guidelines provide that if compounds share a common chemical structure which occupies a large portion of their structure and all the claimed compounds are alleged to possess the same use, unity would be present. See Example 20, Chapter 10 of the International Search and preliminary Examination guidelines. Thus, claims 1-26 share a common technical feature and unity is present.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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